

REMARKS

Reconsideration of this application, as amended, is respectfully requested.

In the Official Action, the Examiner maintained the rejections of the claims from the previous Official Action. Specifically, the Examiner rejected claims 1, 2 and 4 under 35 U.S.C. § 102(a) as being anticipated by U.S. Patent Application Publication No. 2002/0045801 to Niida et al., (hereinafter “Niida”). Furthermore, the Examiner rejected claims 5 and 6 under 35 U.S.C. § 103(a) as being unpatentable over Niida in view of U.S. Patent No. 4,757,347 to Tamaoki et al. (hereinafter “Tamaoki”).

In response to the rejections in the Final Official Action, independent claim 1 has been amended to clarify its distinguishing features.

In the previous response, Applicants argued that Niida is directed to a conventional endoscope (reference numeral 1 in Figure 1), not to a capsule endoscope and that the temperature detection means referred to by the Examiner is not within the endoscope, but is housed within the main apparatus (light source unit) that the endoscope plugs into (see Figure 1).

With regard to our argument that Niida discloses a conventional endoscope (not a capsule endoscope), the Examiner argues (at paragraph [06] of the “Response to Arguments” section of the Final Official Action) that “Niida discloses a ‘capsule endoscope’ in so far as he anticipates the recited structures.” In this regard, the Examiner also argues that “the preamble is given limited patentable weight based on the fact that there are no structurally limiting recitations of a capsule.” Thus, it appears that the Examiner feels that the claims do not recite any features of the capsule endoscope.

Although Applicants disagree with the Examiner, in the interests of advancing prosecution, claim 1 has been amended to clarify the structural features of a capsule endoscope, which are not shared with conventional endoscopes, such as that disclosed in Niida. Specifically, the capsule endoscope of claim 1 now recites:

“a swallowable capsule housing configured to be swallowed by a patient;

an image pickup unit, a wireless communication unit, a lighting unit and a signal processing unit, each of which being disposed in the swallowable capsule housing;

temperature detection means disposed in the swallowable capsule housing and arranged in at least one of internal electric circuits and which detects an internal temperature of the corresponding internal electric circuit, converts information indicating the detected temperature into an electric signal in a predetermined format, and generates the electric signal, the internal electric circuits comprising one or more of the image pickup unit, the signal processing unit, the wireless communication unit, and the lighting unit, respectively;

temperature determination means disposed in the swallowable capsule housing for performing a predetermined determination on the basis of the electric signal generated from the temperature detection means; and

power control means disposed in the swallowable capsule housing for controlling power supply to the corresponding internal electric circuit on the basis of the determination result obtained by the temperature determination means.”

The amendment to claim 1 is fully supported in the original disclosure. Thus, no new matter has been entered into the disclosure by way of the present amendment to claim 1.

With regard to the rejection of claims 1, 2 and 4 under 35 U.S.C. § 102(a), a capsule endoscope having the features discussed above and as recited in independent claim 1 is nowhere disclosed in Niida. Since it has been decided that “anticipation requires the presence in a single prior art reference, disclosure of each and every element of the claimed

invention, arranged as in the claim,”¹ independent claim 1 is not anticipated by Niida. Accordingly, independent claim 1 patentably distinguishes over Niida and is allowable. Claims 2 and 4 being dependent upon claim 1 are thus at least allowable therewith.

With regard to the rejection of claims 5 and 6 under 35 U.S.C. § 103(a), since independent claim 1 patentably distinguishes over the prior art and is allowable, claims 5 and 6 are at least allowable therewith because they depend from an allowable base claim.

Furthermore, the Applicants again respectfully submit that at least claims 5 and 6 patentably distinguish over the cited references independently of their base claim for at least the reasons set forth in the previous response, the contents of which (with regard to claims 5 and 6) is incorporated herein by reference.

In view of the above, it is respectfully submitted that this application is in condition for allowance. Accordingly, it is respectfully requested that this application be allowed and a Notice of Allowance issued. If the Examiner believes that a telephone conference with Applicants' attorneys would be advantageous to the disposition of this case, the Examiner is requested to telephone the undersigned.

Respectfully submitted,



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¹ Lindeman Maschinenfabrik GMBH v. American Hoist and Derrick Company, 730 F.2d 1452, 1458; 221 U.S.P.Q. 481, 485 (Fed. Cir., 1984).